

REMARKS**I. OVERVIEW**

Claims 1-7, 9, 10 and 12-14 are pending in the present application. In the previous action, claims 11-14 were indicated to be allowable if rewritten to include the limitations of their base claim and any intervening claims. Applicant's response to that prior action added the limitations of claim 11 and intervening claim 8 to their base claim 1 and cancelled claims 8 and 11. The remaining claims are dependent on amended claim 1. It was believed that this put the claims in form for allowance. However, these claims continue to be rejected. This response is an earnest attempt to place the application in form for allowance or at least in better form for appeal. Entry and reconsideration are respectfully requested.

II. 35 U.S.C. § 101 REJECTION

The only remaining issue in the application is the § 101 rejection of all pending claims set forth at pages 2-5 of the Office Action. All other objections and rejections, including §§ 102, 103, and 112 rejections, have been withdrawn. The § 101 rejection is respectfully traversed by the Applicants.

The Examiner expresses the following basis for the rejection: that the invention is not within the "technical arts" (citing *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970) and *Ex parte Bowman*, 61 USPQ2d (BNA) 1669(BdPatApp&Int 2001)). Specifically, the Examiner argues:

In the present application, method claim 1 does not recite a useful, concrete and tangible result (i.e. no development of criteria of any performance for the job position), and the claim further recite no structural limitations (i.e., computer implementation). None of the steps in the body of the claim indicates any connection to a computer or technology. The steps of "defining..., preparing..., and surveying..." could be performed manually by a person without use of technology means.

Office Action, pages 4-5.

Applicant respectfully submits additional language need not be added to the claims to make them statutory (particularly any explicit recitation of utilization of a computer). The only independent claim (claim 1), is a method claim. It is not an apparatus claim. Furthermore, the claim 1 explicitly recites the following steps which are explicit tangible actions: (a) surveying and (b) preparing a report. And finally, the claim preamble (the "result" of the method) calls for developing criteria for performance of the job. By "defining" the job, the criteria of performance for the job is developed. *See, Applicants' specification, pg. 6, line 28 through pg. 7, line 1:*

| Other objects, features and advantages of the present invention include, but are not limited to:

1. A focus on first defining a job by competencies and the most important competencies.
2. Utilization of such a defined job to (a) screen potential employees for the job, (b) evaluate existing employees in the job,

See also the "Summary of the Invention" at pgs. 9-10.

It is respectfully submitted that claim 1 meets the "technical arts" and "concrete, useful, tangible" tests as well as the cases cited by the Examiner. It is furthermore respectfully submitted that "computerization" is not the touchstone for statutory subject matter. The mere step of preparing a report (Claim 1, step (d)) is sufficient concrete, tangible post-processing of the method to meet statutory subject matter.

The Examiner is again directed towards the most recent U.S. Supreme Court authority on patent-eligible subject matter, *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 122 S.Ct. 593 (2001), interpreting the language of 35 U.S.C. § 101 to be extremely broad. The Supreme Court also recognized that Section 101 is a dynamic provision designed to encompass new and unforeseen inventions. Therefore, the U.S. Supreme Court's most recent articulation of 35 U.S.C. § 101 provides a far broader view of patent eligible subject matter than that which is articulated in the Office Action. 35 U.S.C. § 101 means what it says when it defines "any new and useful process" as being patent eligible subject matter and the categories of § 101 are not limiting. *See, e.g., J.E.M. Ag Supply* at 598 (citing to *Diamond v. Chakrabarty*, which held that anything "under the sun" made by man is eligible for patenting under § 101). To the extent that the Examiner's cited authority is inconsistent with *J.E.M. Ag Supply, Inc.*, it is simply overruled or not controlling.

However, while Applicant does not agree that the claims of this application require the addition of a computer or some computerization, or other additions, to advance prosecution of the application, claim 1 has been amended. The amendment attempts to follow the Examiner's comments in the Action and certainly meets even the standards recited in the Office Action for patentable subject matter.

First, the preamble has been amended to recite one useful end result according to one aspect of the invention -- evaluating potential for job performance. Evaluation of the potential for a job applicant or existing worker for performance in a particular job is supported throughout the Applicants' specification. *See, e.g., Applicants' specification pg. 2, lines 10-17.*

Step (c) of claim 1 has been amended to clarify that the job is defined by ascertaining specific job characteristics from the surveying of step (b) that are relevant for performance in the

job. Thus, it is submitted that the body of the claim includes limitations regarding how the job is defined and linking that definition with the claim.

Step (d) of claim 1 has been amended to include language that the report is "computerized" and documents the criteria for performance of the job identified in step (c). Thus, it is submitted this overcomes the Examiner's objection that the claim lacks computer implementation.

A closing clause has been added which further adds computerization clarifies the method can be used to It is submitted this further emphasizes, in the body of the claim, the concrete, useful, and tangible result of the method. It can be used to determine which potential employees to hire and whether existing employees are performing well.

Other minor changes have been made to claim 1 for clarity and consistency.

It is respectfully submitted that claim 1, as amended, adds language suggested by the Examiner which overcomes any § 101 issue. Reconsideration is respectfully requested.

New independent claim 21 has been added. It is respectfully submitted to be allowable for the same reasons amended claim 1 is submitted to be allowable.

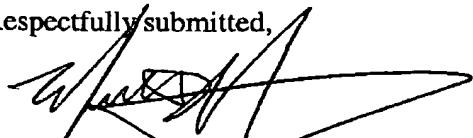
III. CONCLUSION

It is respectfully submitted that all matters raised in the Office Action have been addressed and remedied and that the claims are in form for allowance. Favorable action is respectfully requested.

This is a request to extend the period for filing a response in the above-identified application for one month from January 19, 2005 to February 19, 2005. Applicant is a small entity; therefore, please charge Deposit Account number 26-0084 in the amount of \$60.00 to

cover the cost of the one month extension. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084.

Respectfully submitted,


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